IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No:	10/798,786
Appellant:	Robert A. Van Tassel et al.
Filed:	March 10, 2004
Title:	METHODS FOR TREATMENT OF ANEURYSMS
T.C./A.U.:	3739
Examiner:	Roy Dean Gibson
Confirmation No.:	5624
Docket No.:	BSI-557US1 (formerly ENDOV-67986)

REPLY BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed on February 17, 2009. The arguments set forth herein address issues raised in the Examiner's Answer and supplement the arguments set forth in the Appeal Brief filed on October 29, 2008.

This Brief is presented in the format required by 37 C.F.R. § 41.37, in order to facilitate review by the Board. In compliance with 37 C.F.R. § 41.37(a)(1), this Brief is being filed within two months from the date of mailing of the Examiner's Answer.

TABLE OF CONTENTS

I. STATUS OF CLAIMS

Claims 61-71 and 73 are pending. Claim 67 is allowed. Claims 61-66, 68-71 and 73 stand rejected. Claims 61-66, 68-71 and 73 are the subject of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 61, 62, 64-66 and 68 are unpatentable under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 6,488,673 (Laufer et al.).

B. Whether claims 63, 69-71 and 73 are unpatentable over U.S. Patent No. 6,488,673 (Laufer et al.) in view of U.S. Patent No. 5,913,884 (Trauner et al.) under 35 U.S.C. § 103(a).

III. ARGUMENT

A. Rejection Under 35 U.S.C. §102(e) Over U.S. Patent No. 6,488,673

In response to Appellants' assertion that the Office Action does not include a basis in fact and/or technical reasoning to reasonably support that the heating of the inner wall inherently heats the outermost connective tissue of the vessel (adventitial area of the tissue), the Examiner's Answer states "since the adventitial area is adjacent to the inner wall of a vessel (only microns away), then the heat applied to the innner wall would inherently be conducted to the adventitial area as well, resulting in the increase in area of the adventitial area, even if by a fraction of a percent."

As explained in the Appeal Brief, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. §2112 citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Reply Brief still fails to provide any basis that the alleged inherent characteristic necessarily flows from the teaching of Laufer et al. Under the teachings of Laufer et al., it is equally plausible that only sufficient heat or energy is applied to only heat the inner smooth tissue. This is particularly true based on the teachings of Trauiner et al. As explained in the Appeal Brief, Trauner et al. teaches that a low dose therapy targets only a small percentage of cells, i.e. 10% or less of the cells, and if a high dose therapy were utilized, such might result in an inhibiting of fibrosis. Therefore, it is not inherent that the agent would be taken up in the adventitial area nor that such would inherently result in increasing the adventitial area.

The Examiner's Answer also contends that Laufer et al. teaches the same steps as the claimed invention, but does not provide support for such assertion. To the contrary, Laufer et al. teaches applying agent and energy to the inner surface which is distinct from the claimed invention.

Since Laufer et al. does not disclose every limitation of the claimed invention, either expressly or inherently, the claimed invention is not anticipated thereby. Appellants respectfully request reconsideration and reversal of the rejection of claims 61, 62, 64-66 and 68 under 35 U.S.C. §102(e).

Accordingly, for at least the above reasons, appellants respectfully contend that independent claims 61, 67 and 69 and dependent claims 62-66, 68, 70, 71 and 73 of this application are now in condition for allowance. Accordingly, appellants respectfully request reversal of the Final Rejection.

B. Rejection Under 35 U.S.C. §103(a) Over U.S. Patent No. 6,488,673 in View of U.S. Patent No. 5,913,884

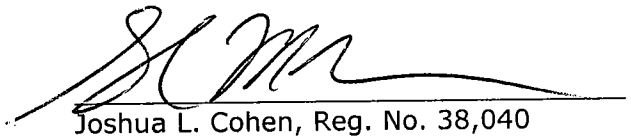
The Examiner's Answer does not provide any response to the arguments set forth in the Appeal Brief relative to the rejections under 35 U.S.C. §103(a). Appellants maintain that the cited references, alone or in any reasonable combination, fail to teach or suggest each limitation of the claimed invention for at least the reasons set forth in the Appeal Brief.

IV. CONCLUSION

In view of the arguments set forth above, all pending claims are patentable over the cited references. The rejection of all of the pending claims of record should therefore be reversed with instructions to issue a Notice of Allowability. Such actions are respectfully requested.

Respectfully Submitted,

RatnerPrestia



Joshua L. Cohen, Reg. No. 38,040
Glenn M. Massina, Reg. No. 40,081
Attorneys for Appellants

JLC/GMM/

Dated: April 17, 2009

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.